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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,607	01/22/2001	Kevin A. Owen	10002024-1	2528

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/767,607	OWEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 7/5/05.
- Claims 1-9, 11-20 are pending in application; claim 10 has been canceled.

#### ***Response to Arguments***

Applicant's arguments, see pages 7-8 filed on 7/5/05, with respect to the rejection(s) of claim(s) 1 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references.

#### **Claim Rejections - 35 USC § 101**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions.

The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

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“Medium” as cited in claim 20 is directed to a non-statutory subject matter, for example, medium can be interpreted as a “paper media” contains printed computer program instructions. The examiner recommends the applicants to replace “medium” with “computer readable medium” so it compliances with 35 U.S.C. 101.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, 13-16, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Millman et al (US 5363204).

Regarding claim 1, Millman discloses a hardcopy device (facsimile apparatus 100, fig. 1) comprising:

- a processor (CPU 101, fig. 1);
- an image printing unit (printer 112, fig. 1) which is controlled by said processor and fed by a print media supply and handling unit; and
- a memory unit (ROM 103 and help memory 104, fig. 1) containing an electronic document file (files containing information about facsimile apparatus, col. 2, line 62-64) which is retrieved, on command (via help menu as shown in fig. 3), from said memory by said processor and printed in hardcopy form (printed in hardcopy, col. 1, lines 45-67 and col. 4, lines 8-15) by said image printing unit;
- wherein said electronic document file is a document describing features (features of facsimile apparatus, figs. 2-6) of said hardcopy device.

Regarding claim 2, Millman further discloses the device of claim 1, wherein said memory unit is a read-only memory unit (ROM 103, fig. 1) and contains said electronic document file.

Regarding claim 3, Millman further discloses the device of claim 1, further comprising a user interface unit (operational control panel 105, fig. 1) with which a user can issue a command (commands as shown in figs. 3 and 6) for said device to print said electronic document file in hardcopy form.

Regarding claim 4, Millman further discloses the device of claim 3, wherein said user interface unit displays a menu (menu as shown in fig. 3 and 6) from which said command is issued in response to selection of a corresponding menu item.

Regarding claim 5, Millman further discloses the device of claim 3, further comprising a display (output display 108 of control panel, fig. 1) associated with said device which advertises a specific manipulation (features of facsimile apparatus, fig. 3 and 6) of said user interface device that will issue said command.

Regarding claim 6, Millman further discloses the device of claim 1, further comprising a connection to a host device (communication system 1100, fig. 11, col. 7, lines 45-54), wherein said host device issues said command (communication system 1100

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access printer's help menu and to print document as desired, col. 7, lines 45-55) to print said electronic document file.

Regarding claim 11, Millman further discloses the device of claim 1, wherein said hardcopy device is a facsimile machine (facsimile apparatus 100, fig. 1) further comprising a modem (modem 113, fig. 1) and connection to a phone line (network interface 110, fig. 1).

Regarding claim 13, Millman discloses a method of advertising the features of a hardcopy device (features of facsimile apparatus, figs. 2-6), which hardcopy device includes a processor (CPU 101, fig. 1); an image printing unit (printer 112, fig. 1) which is controlled by said processor and fed by a print media supply and handling unit (inherently, all facsimile apparatus includes a print media supply and handling unit); and a memory unit (ROM 103 and help memory 104, fig. 1) containing an electronic document file, wherein said electronic document file is an electronic document describing features (files containing information about facsimile apparatus, col. 2, line 62-64) of said hardcopy device, said method comprising retrieving said electronic document file, on command (via help menu as shown in fig. 3), from said memory and printing said electronic document file in hardcopy form (printed in hardcopy, col. 1, lines 45-67 and col. 4, lines 8-15) with said image printing unit.

Regarding claim 14, Millman further discloses the method of claim 13, further comprising issuing said command for said device to print said electronic document file in

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hardcopy form with a user interface unit (operational control panel 105, fig. 1) of said hardcopy device.

Regarding claim 15, Millman further discloses the method of claim 14, further comprising associating a display with said device which advertises a specific manipulation features of facsimile apparatus, fig. 3 and 6) of said user interface device that will issue said command.

Regarding claim 16, Millman further discloses the method of claim 13, further comprising displaying a menu (via help menu as shown in fig. 3) from which said command is issued in response to selection of a corresponding menu item.

Regarding claim 20: Claim 20 recites limitations that are similar and in the same scope of invention as to those in claim 1 except computer readable memory for storing computer programs. All computers/printers have some type of computer readable medium (i.e. ROM, fig. 1) for storing computer programs, hence claim 20 would be rejected using the same rationale as in claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8, 12, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millman as described in claims 1 and 13 above, and in view of Hirst et al (US 5930553).

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Regarding claims 7, 12, 17, 19, Millman teaches an image forming device as shown in fig. 1 further comprising a connection to a host device (fig. 11), but fails to teach and/or suggest an updated electronic document file is downloaded from said host device to said hardcopy device.

Hirst, in the same field of endeavor for image forming apparatus, teaches a well known in the art at the time of the invention to have an updated electronic document file downloaded (downloading/updating information from manufacture's host device, fig. 5, col. 1, lines 57-60, col. 2, lines 45-50, and col. 6, lines 13-21) from said host device to said hardcopy device (hardcopy device 10, fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify facsimile apparatus of Millman to include a method of automatically downloading an updated/new features of facsimile apparatus from host device as taught by Hirst because of a following reason: (●) periodically receiving updated information from manufacture's host device and downloading new features (e.g. new printer driver) automatically without any human invention reduces personnel costs and to improve the overall performances of the facsimile apparatus of Millman (col. 2, lines 45-50 and col. 6, lines 10-12 of Hirst).

Therefore, it would have been obvious to combine Millman with Hirst to obtain the invention as specified in claims 7, 12, 17, 19.

Regarding claim 8, Millman further teaches the device of claim 1, further comprising a static memory unit (SRAM 114, fig. 1).

Claims 9 & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millman as described in claims 1 and/or 13 above, and in view of Lee (U.S. 6628413).

Regarding claims 9 & 18, Millman does not disclose wherein hardcopy device comprising an embedded Web Browser for downloading an updated electronic document file from the Internet or Web.

Lee, in the same field of endeavor for printer, teaches a well known in the art at the time of the invention to have a hardcopy device comprising an embedded Web



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Browser (Java printer comprising a Web Brower for downloading/uploading updated parameters, col. 5, lines 8-65) for downloading an updated electronic document file from the Internet or Web.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify facsimile apparatus of Millman to include a WEB browser as per teachings of Lee because of a following reason: (●) to allow operators/users to connect to the WEB from the printer without having to use the host computer; therefore, reducing hardware costs.

Therefore, it would have been obvious to combine Millman with Lee to obtain the invention as specified in claims 9 & 18.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

  
GABRIEL GARCIA  
PRIMARY EXAMINER